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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,092	10/30/2006	Bernd Meyer	30882/DP037	4464
4743 7590 10/29/2010 MARSHALL, GERSTEIN & BORUN LLP 233 SOUTH WACKER DRIVE 6300 WILLIS TOWER CHICAGO, IL 60606-6357			EXAMINER WU, RUTAO	
			ART UNIT 3628	PAPER NUMBER
			NOTIFICATION DATE 10/29/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@marshallip.com

Office Action Summary

Application No.

10/573,092

Applicant(s)

MEYER ET AL.

Examiner

ROB WU

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4 and 7-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4 and 7-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date 11/23/2009

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 23 2009 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 4, 7-19 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 4, 7-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pub No 2005/0102203 to Keong in view of U.S. Pub No 2009/0182687 to Stickler et al.

Referring to Claim 1:

A method for producing a postal item, whereby order data for a postal item that is to be printed and/or sent is generated in an order component, the method comprising:

Keong discloses

Receiving electronic order data [0094]

Breaking down the electronic order data into address information of a recipient and a goods identification code [0098]

Preparing the address information in a form that can be linked to the goods; [0098]

Linking the goods to the address information, [0098]

Delivering the goods linked to the address information as a postal item. [0098]

Keong does not expressly disclose that the postal item having a generated postal indicium taking into account the address information of the recipient, where franking information and address information are combined and incorporated into the postal indicium to increase franking security.

Stickler et al disclose generating a postal indicium taking into account the address information of the recipient, where franking information and address information are combined to incorporate into the postal indicium to increase franking security. [0037]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Keong to incorporate the postal indicium featured in Stickler et al since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did

separately. Therefore, one ordinary skill in the art would have recognized that the results of the combination were predictable.

Referring to claim 4:

the method according to claim 3,

Keong discloses comprising the transaction computer performing an automatic comparisons between the stock of goods and one or more pending orders. [0097]

Referring to Claim 7:

Keong do not expressly disclose the transaction computer transmits the address information of the customer who placed the highest bid in the auction procedure to a computer of a seller who is offering the goods for sale at auction.

Stewart discloses a transaction computer transmitting the address information of the customer who placed the highest bid in the auction procedure to a computer of a seller who is offering the goods for sale at auction.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Keong to incorporate the auction system as disclosed by Stewart since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately. The auction system and the goods picking system would continue to function the same in the combination as it did separately. Therefore, one ordinary skill in the art would have recognized that the results of the combination were predictable.

Referring to claim 8:

Keong discloses the method according to claim 1, comprising generating a postage indicium for the postal item in an automated process. [0092]

Referring to claim 9:

Keong discloses the method according to claim 8, comprising controlling the generation of the postage indicium by a warehouse management control unit. [0092]

Referring to claim 10:

Keong discloses the method according to claim 8, comprising controlling the generation of the postage indicium by a computer of the recipient. [0092]

Referring to claim 11:

Keong discloses the method according to claim 8, comprising notifying the recipient of the execution of the franking. [0092]

Referring to claim 12:

A device for generating a postal item,
comprising, in combination:
a computer for receiving and storing address information of a recipient and a goods identification code that identifies the goods; [0074], [0075], [0094], [0124]
a means for linking the goods to the address information, [0098] and
a postal service provider for delivering the goods linked to the address information as a postal item. [0098]

Keong does not expressly disclose that the postal item having a generated postal indicium taking into account the address information of the recipient, where

franking information and address information are combined and incorporated into the postal indicium to increase franking security.

Stickler et al disclose generating a postal indicium taking into account the address information of the recipient, where franking information and address information are combined to incorporate into the postal indicium to increase franking security. [0037]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Keong to incorporate the postal indicium featured in Stickler et al since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately. Therefore, one ordinary skill in the art would have recognized that the results of the combination were predictable.

Referring to claim 13:

The device according to claim 12,

Keong discloses wherein the means to link the goods to the address information is a printer. [0131]

Referring to claim 14:

The device according to claim 12,

Keong discloses wherein the means to link the goods to the address information is a transmitter that is designed in such a way that it can transmit the address information to a transponder that can be affixed to the goods. [0126]

Referring to Claim 15:

Keong discloses

The method according to claim 1, comprising storing the electronic order data in a transaction computer. [0098]

Referring to Claim 16:

Keong discloses

The method according to claim 15, comprising a warehouse management control unit transmitting the electronic order data to a material flow control computer and the material flow control computer controlling material flow in such a way that the goods and/or additional goods are placed into picking containers and/or directly into a transport container provided for the shipment as a postal item. (Fig 1, Fig 7B, 7C)

5. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keong in view of Stickler et al in further view of U.S. Pub No 2001/0049634 to Stewart.

Referring to Claim 17:

Keong does not expressly disclose the transaction computer controls an automatic auction procedure.

Stewart discloses an automatic auction system that stores the order data of the highest bidder of the auction along with the product data involved in the auction. [0026], [0104]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Keong to incorporate the auction system as disclosed by Stewart since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same

function as it did separately. The auction system and the goods picking system would continue to function the same in the combination as it did separately. Therefore, one ordinary skill in the art would have recognized that the results of the combination were predictable.

6. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keong in view of Stickler et al in further view of U.S. Pub No 2004/0254897 to Boden.

Referring to Claims 18 and 19:

Keong combined with Stickler et al do not expressly disclose wherein the address information and franking information are combined into a machine-readable matrix code and that the matrix code is cryptographically secured.

Boden discloses a postage indicia wherein the address information and franking information are combined into a machine-readable matrix code and that the matrix code is cryptographically secured. [0025]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Keong and Stickler et al to combine the cryptographically secured matrix code postage indicia as disclosed by Boden since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately. Therefore, one ordinary skill in the art would have recognized that the results of the combination were predictable.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROB WU whose telephone number is (571)272-3136. The examiner can normally be reached on Mon-Fri 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571)272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/RUTAO WU/
Examiner, Art Unit 3628